

### **REMARKS**

This Amendment and the following remarks are intended to fully respond to the Office Action mailed September 26, 2005. Claims 1-28 were examined in that Office Action, and all claims were rejected. More specifically, claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Brown et al. (USPN 6,067,551); claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al.; claims 1, 3, 5, 9, 10, 13, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. (USPN 5,890,177); and claims 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. in view of Thorne et al. (USPN 5,958,005).

In this Response, claims 18-20 have been amended to correct their dependencies. No claims have been canceled and no new claims have been added. Accordingly, claims 1-28 are pending for examination. Reconsideration of the Examiner's rejections, as they may apply to the original and amended claims, and further Examination of the pending claims are respectfully requested.

#### **Claim Rejections – 35 U.S.C. § 102**

The Examiner maintains the previous rejection of claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28 under 35 U.S.C. § 102(e) as being anticipated by Brown et al. (USPN 6,067,551). The Examiner continues to assert that Brown et al. disclose all the elements of claims 1, 2, 4-6, 8, 13, 14, 16, and 21-28. The rejection is respectfully traversed.

#### **Legal Authority Relevant to 35 U.S.C. § 102**

With respect to establishing anticipation of a claim, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added)). Although the inherent disclosures of a reference may be used to show anticipation of a claim,

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Inherency, however, may not be established by probabilities or possibilities.

The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added)).

Moreover, to establish inherency, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)).

**Brown et al.**

As stated in previous responses, Brown et al. teach a method of controlling multi-user editing of a master copy of a document using a multi-user control file (MCF). *See* Brown et al., at Abstract and col. 2, lines 51-56. The MCF is created on a file server that stores the master copy of the document. *Id.* The MCF is not created on any remote computer. *See* Brown et al., at col. 4, lines 11-14. The MCF provides access, for remote users, to the master copy on the file server. *Id.* The MCF is associated only with the master copy, stored only with the master copy, and is the only process controlling the linking between the master copy on the file server and the copies used by the remote users. *See* Brown et al., at col. 5, lines 40-44.

The MCF tracks all versions of the master copy being edited by one or more users. *See* Brown et al., at col. 2, lines 52-56. In addition, the MCF administers the synchronization of the different versions that have been or are being edited by the different users. *See* Brown et al., at col. 2, lines 56-65. To accomplish the synchronization, the MCF contains a record for each version of the master copy that is being edited by remote users. *See* Brown et al., at col. 11, lines 45-48. The records in the MCF include an unlock/lock flag, a document name, a master copy version identifier, and a date the master copy was last edited. *See* Brown et al., at col. 13, lines 30-47.

**Brown et al. Do Not Anticipate The Claims**

Claims 1, 5, 13, and 21 differ from Brown et al. because they do not relate to a central server process. Claims 1, 5, 13, and 21 each store the path of the original document with the local copy. Having the path of the original document stored with the local copy allows the remote computers to find the original document and merge any changes with the original document without a central server process, such as the MCF used by Brown et al. A process that stores the path of the original document with the local copy to provide distributed control of the multi-user editing process is in stark contrast with the invention of Brown et al., which requires a central server process.

Additionally, the Examiner relies on a theory of inherency for establishing that Brown et al. disclose storing a path of the original document with the local copy. However, the Examiner does not provide the required basis in fact and/or technical reasoning to support the assertion that Brown et al. disclose a process that “necessarily” includes storing a path of the original document with the local copy. The Examiner cannot establish inherency by “the mere probability or possibility” that Brown et al. store a path of the master copy with the local copy, but must provide a line of reasoning that shows that this is necessarily the case. *See*, MPEP 2112 (quoted *supra*).

Moreover, a process in which the path of the original document is stored with the local copy is inconsistent with the process disclosed by Brown et al., because it raises the possibility of bypassing the MCF by using the path of the original document stored with the local copy—for example, if the MCF is locked for saving edits by another user. Thus, not only has the Examiner failed to put forth the requisite reasoning to establish that Brown et al. “necessarily” includes storing a path of the original document with the local copy, but the teachings of Brown et al. would lead one of ordinary skill in the art to the opposite conclusion.

Furthermore, specifically with respect to claim 1, Brown et al. do not disclose that “in response to a determination that the original document is still in use by another user, saving the local copy with the path of the original document such that a subsequent merge of the saved local copy and the original document can be performed.” The Examiner refers to the save operation disclosed by Brown et al. as disclosing this element of claim 1. However, Brown et al. do not disclose that when the master copy is locked and a user tries to save edits, that the process saves a copy of the local copy with the path of the master copy. Rather, Brown et al. state:

At step 255, User 1 edits the local copy 65. At step 260, User 1 saves the edits made to User 1's local copy 65. At step 265, the method determines whether the MCF 100 is unlocked. If the MCF 100 is locked at step 265, the method follows the "no" branch to step 270. At step 270, the WP 36a displays a dialog box to User 1 on the monitor of the remote computer 49 instructing User 1 to retry the saving request. User 1 tries to save the edits again at step 260. If, at step 265, the MCF 100 is unlocked, the method implemented by the WP 36a follows the "yes" branch to step 275 in FIG. 2C. Brown et al., col. 12, lines 25-35 (emphasis added).

Accordingly, Brown et al. disclose that when the master copy is unavailable for saving changes made by a user on a local copy, the user is prompted to retry saving the document. *Id.* This is distinct from claim 1, which saves the local copy with a path of the original document for merging later with the original document.

Additionally, with respect to claim 5, Brown et al. do not disclose the elements of claim 5, which recite monitoring the original document; and in response to a determination that the original document is no longer in use, notifying a user that the original document is no longer in use.

For at least these reasons, Applicant respectfully requests reconsideration of the rejections to claims 1, 5, 13, and 21 in view of Brown et al. as each of these claims are distinguishable over Brown et al.

Claims 2-4, 6-12, 14-20, and 22-28 are also patentable over Brown et al. as these claims depend from claims 1, 5, 13, and 21, and thus recite elements that further distinguish the claimed invention from Brown et al.

### **Claim Rejections – 35 U.S.C. § 103**

Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown et al. in view of Pham et al. (USPN 6,560,71). Claims 1, 3, 5, 9, 10, 13, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. Claims 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moody et al. in view of Thorne et al. (USPN 5,958,005).

**Legal Authority Relevant to 35 U.S.C. § 103**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §706.02(j) (emphasis added).

**Moody et al.**

Moody et al. disclose a process for editing of a document by multiple editors. *See* Moody et al., col. 2, lines 30-32. Each editor edits his own copy of a document to produce an edited copy. *See* Moody et al., col. 2, lines 32-34. Moody teaches returning the edited copies of the document to an author by means of email and/or floppy disk, all revisions of a document. *See* Moody et al., at col. 4, lines 48-52. The methods for returning a document to an author each relate to a manual approach by which an editor is required to actively submit an edited version to the author of an original document. *Id.* The author of the document receives all the edits and merges the changes, and the distributed system does not need to manage the storing or merging operations. *See* Moody et al., at col. 4, lines 52-63.

**The Examiner Has Not Established A Prima Facie Case Of Obviousness**

**Claims 7 and 15**

Claims 7 and 15 depend from claims 5 and 13, respectively, and are allowable for at least the same reasons. As explained above, Brown et al. do not teach or suggest storing the path of the original document with the local copy, and further with respect to claim 5, monitoring the original document and in response to a determination that the original document is no longer in use, notifying a user that the original document is no longer in use. Pham et al. fails to make up the difference. Rather, Pham describes the backing-up of registry keys onto a remote computer. *See* Pham et al. at col. 2, lines 44-50. As such, the combination of Brown and Pham does not teach or suggest all the claim limitations, and consequently, the Examiner has not established a prima facie case of obviousness.

Claims 1, 3, 5, 9, 10, 13, 17, and 18

With respect to Claims 1, 5, and 13 (as well as claim 21) Moody et al. do not teach or suggest storing a path of the original document with the local copy because such information is not needed to conduct the editing of the document. Moreover, the Examiner has not provided any line of reasoning to indicate why someone of ordinary skill in the art would modify the teachings of Moody et al. to include storing a path of the original document with a local copy.

Moody et al. fails to teach any method for retrieving edited versions of an original document other than prior art methods involving submission by email and floppy disk. These prior art methods each relate to a manual approach by which an editing user is required to actively submit an edited version to the author of an original document. Submission of edited versions of a document using either approach necessarily teaches away from the storage of a location identifier (e.g., path) for the original document in connection with local copies. An editor submits his edited copy manually to the author, and there is no reason why an editor would need to store a path of the original document, particularly because the consolidating is performed by the author after an edited copy has been returned to the author. *See* Moody et al., at col. 4, lines 52-63.

As stated in previous responses, modifying Moody et al. (1) to include such a feature and (2) to imply that such modification would have been obvious to one of skill in the art is not supported by the disclosure of Moody et al. and could only be rendered from the use of impermissible hindsight gleaned from the benefits of the present invention. *See, Ex parte Haymond*, 41 USPQ2d 1217, 1220 (Bd. Pat. App. & Int. 1996).

For at least the foregoing reasons, claims 1, 5, and 13 (as well as claim 21) are patentable over Moody et al. Furthermore, claims 3, 9, 10, 17, and 18 each depend from one of claims 1, 5, 13 and 21, and therefore are allowable for reciting at least those limitations of the independent claims deficient from the teachings of Moody et al. and because they recite additional limitations that further distinguish over Moody et al.

Claims 11, 12, 19, and 20

As explained above, Moody et al. do not teach or suggest storing the path of the original document with the local copy. Thorne et al. does not compensate for the inadequacies of Moody et al. Thorne et al. teach creating email messages with configurable security settings that allow the user to tailor the handling of each email message according to that message's security

settings. *See* Thorne et al. at Abstract. Thorne never teaches or suggests storing the path of the original document with the local copy. As such, the combination of Moody et al. and Thorne et al. does not teach or suggest all the claim limitations, and consequently the Examiner has not established a prima facie case of obviousness.

For at least these reasons, Applicant respectfully requests reconsideration of the rejections to all of the pending claims 1-28 in view of Brown et al., Moody et al., Pham et al., and Thorne et al. as each of these claims are believed to recite the present invention in a manner distinguishable over the above references individually and in any combination.

**Conclusion**

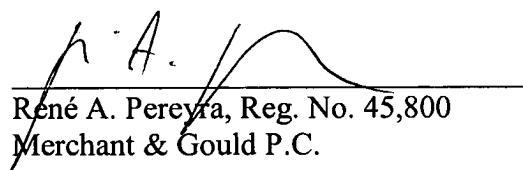
It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725. Moreover, since the remarks above are believed to distinguish over the applied reference(s), Applicants specifically do not acquiesce to any other arguments not addressed herein that arguably support the claim rejections.

In view of the above remarks and amendments, it is believed that the application is now in condition for allowance and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

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Respectfully submitted,

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